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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/658,347

09/09/2003

Kenichiro Fujieda

032405.151

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06/09/2005

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EXAMINER

KLEBE, GERALD B

ART UNIT

PAPER NUMBER

3618

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

BN

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/658,347 | <b>Applicant(s)</b><br>FUJIEDA, KENICHIRO |  |
|                              | <b>Examiner</b><br>Gerald B. Klebe   | <b>Art Unit</b><br>3618                   |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 5 is/are allowed.
- 6) ☒ Claim(s) 2-4 and 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

*G.B. Klebe*  
2 June 2005

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/15/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Preliminary Amendment***

1. The preliminary amendment filed 09/09/2003 has been entered. Claims 1-10, as amended are pending in the application.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 USC Sec. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

3. The proposed drawing changes to correct Figure 5 filed 01/15/2004 are approved by the examiner.

## **INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

### **Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

### **Annotated Drawing Sheets**

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A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

### **Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification Objections***

4. The specification at page 3, lines 22-25 attempts to incorporate by reference a non-English language document. The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other

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requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

***Claim Objections - Informalities***

5. The claims are objected-to for the following informalities:

In claim 6, line 7, “provide” should be --provided--;

In claim 10, line 2: “is” should be --are--; “on” should be --to--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-4, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 in line 3 recites the limitation “the front”. There is insufficient antecedent basis for this limitation in the claim.

Claims 9 and 10 each recite the limitation “said mounting portions”. There is insufficient antecedent basis for this limitation in these claims.

Appropriate correction is required.

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For the purposes of further examination on the merits, the recitation "the front" in claim 2 will be interpreted as reading --the front space of the engine room--; each of the cited recitations in claims 9 and 10 will be interpreted by the examiner as reading --said supporting portions--.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi (US 6260609).

a. Takahashi discloses a heat exchanger mounting structure in a front space of an engine room of a vehicle, comprising:

(re: claim 6) supporting portions (Fig 1, item 34) provided on a vehicle body supporting the end of an upper part of the heat exchanger (Fig 1, item 21);

connecting members (26) connecting the ends of the upper part of the heat exchanger to the supporting portions (34); and,

elastic members (35; and refer col 3, lines 48ff) provided between the supporting portion and the connecting member (26)s, wherein,

the supporting portions (34) are configured to break when an external force exceeding a predetermined level caused by a vehicle collision is applied to the upper part of the heat exchanger such that the upper part of the heat exchanger moves rearward and downward upon

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breakage of the supporting portions (refer Figs 5(a)-5(c), the associated text at col 4, line 40ff and specifically lines 53-58); and,

(**re: claim 7**) wherein the supporting portions (34) are provided with inclined mounting surfaces (not separately numbered; taken as the top surfaces of item 34 as seen in Fig 2) declining toward the front (refer Fig 2; that shows a top surface of item 34 that declined toward the front of the engine room of the vehicle); and wherein the mounting surfaces are provided with a weak portion configured to deform the supporting portions by when an external force exceeding a predetermined level is applied on the upper part of the heat exchanger (refer col 3, lines 61-62); and, (**re: claim 8**) wherein

the supporting portions (34) are configured to deform rearward and downward along the weak portion (as shown in Fig 5(c)) to cause rearward and downward displacement of the upper part of the heat exchanger (refer col 4, lines 53-58); and.

(**re: claim 10**) wherein the mounting portions (34) are provided on a carrier member (32) attached to the vehicle.

b. Takahashi supports the heat exchanger only at one side (the left side of the vehicle) rather than providing supports at both left and right sides.

c. However, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the disclosure of Takahashi to provide a support at each of the left and right sides as a matter of design choice in order to reduce unwanted vibrations of the heat exchanger due to unsymmetrical supports since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

***Allowable Subject Matter***

10. Claims 1 and 5 are allowed.

Claims 2-4 and 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Reasons for indicated Allowable Subject Matter***

11. The following is a statement of reasons for the indication of allowable subject matter:

The limitations of the independent claim 1 for a structure for mounting a heat exchanger in an engine compartment of a vehicle to enable the mounting to deform, thereby allowing the top portion of the heat exchanger to rotate rearward and downward when a force exceeding a predetermined amount acts on the structure and comprising a cross member laterally extending in the front space of the engine compartment, supporting portions provided on the vehicle body supporting opposite ends of the cross member, elastic members provided between the supporting portion and the ends of the cross member, and connecting members connecting an upper part of the heat exchanger to the cross member, and together with the other recited limitations of the claim are not found in the prior art of record nor may be construed from any reasonable combination to be derived thereof.

***Prior Art made of Record***

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art of Otani; and of Ozawa et al. also show features in common with some of the other structures of the inventive concept disclosed in the instant application.



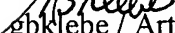
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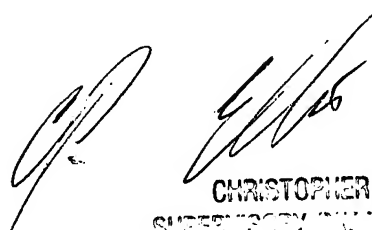
***Conclusion***

13. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 571-272-6695; Mon.-Fri., 8:00 AM - 4:30 PM ET, or to Supervisory Patent Examiner Christopher P. Ellis, Art Unit 3618, at 571-272-6914.

Official correspondence should be sent to the following TC 3600 Official Rightfax numbers as follows: Regular correspondence: 703-872-9326; After Finals: 703-872-9327; Customer Service: 703-872-9325.

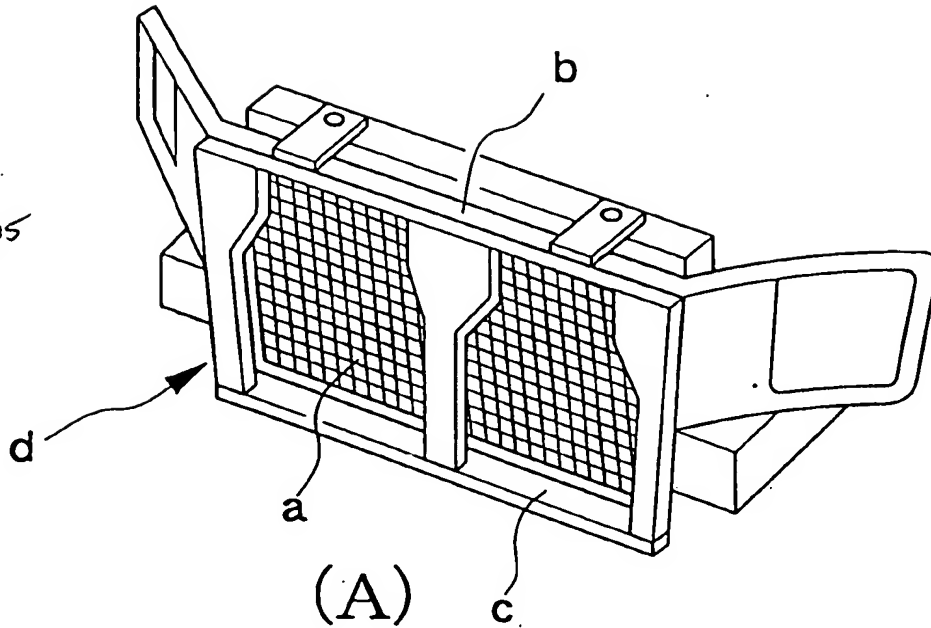
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
gbklebe / Art Unit 3618 / 2 June 2005

  
CHRISTOPHER P. ELLIS  
SUPERVISORY PATENT EXAMINER  
TECHNICAL FIELD: 3618



*Approved  
4/3/05  
26 May 2005*



**FIG. 5**  
(Prior Art)

